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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): STL11321

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on February 6, 2006

Signature: Diana C. Anderson

Typed or printed name: Diana C. Anderson

Application Number	Filed
10/669,185	September 23, 2003

First Named Inventor: Justin Won

Art Unit	Examiner
2651	Jason Olson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: 38,794

Signature

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2/6/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

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PATENT
Dkt. STL11321

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Justin Won, Samir Mittal and EweChye Tan**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/669,185** Group Art: **2651**
Filed: **September 23, 2003** Examiner: **Jason Olson**
For: **INTERLEAVED REPEATABLE RUNOUT ESTIMATION**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

IT IS CLEAR ERROR THAT THE EXAMINER HAS REPEATEDLY REFUSED TO SUBSTANTIATE A PRIMA FACIE CASE OF ANTICIPATION

Following are indisputable facts from the record:

1. There are three independent claims 1, 13, and 21.
2. All of the independent claims recite either a method for or circuitry capable of reading position error signals for non-consecutive revolutions.
3. Codilian '635, upon which the Examiner relies in the anticipatory rejection, discloses reducing error by calculating standard deviation based on averages, not individuals. (see Applicant's Response of 1/4/2006 ppg. 10-11, attachment; Advisory action of 1/30/2006)
4. The Examiner read the "non-consecutive revolutions" limitation onto Codilian '635 by arguing that it discloses reading position error signals during a first revolution at a first track, then seeking away, then seeking back to the first track and reading position error signals again for subsequent revolution(s) at the first track. Thereby, the Examiner argues that the first and subsequent revolution(s) would be "non-consecutive revolutions." (see Office Action of 11/04/2005, ppg. 2-3 and ppg. 4-5)

5. The Applicant argued that the Examiner's claim construction is clearly erroneous because it is based on a mischaracterization of Codilian '635 to the extent beyond what a skilled artisan would reasonably view it discloses, and that absent the mischaracterization the Examiner has failed to substantiate a prima facie case of anticipation, making this case not in condition for appeal. (see, for example, Applicant's Response of 1/ 4/2006 ppg. 8-12)

In some cases an appealable issue can arise based on bona-fide disparate views as to what a reference discloses, either explicitly or by inherency; such is not this case. In making a rejection final, the Examiner's obligation is clear: "shall repeat or state all grounds of rejection...clearly stating the reasons in support thereof." MPEP 706.07. Thus, the Panel need only look at the Examiner's stated grounds in judging the merits of his rejection against his burden. MPEP 706.07 expressly prevents Applicant from making technical or obvious subterfuge arguments in order to prolong prosecution. In so stating, that MPEP provision assumes the Examiner likewise won't rely on technical or obvious subterfuge arguments to prematurely close the merits on an unsubstantiated prima facie case. Applicant prays that from an objective review of the present facts the Panel will agree that assumption has been violated here.

Applicant now addresses the Examiner's stated grounds in order for maintaining the rejection.

1. Associating RRO Measurement With Revolutions is Essential to the RRO Learning of Codilian '635

The Examiner first stated the following as grounds for the final rejection:

> The fact that the standard deviation of an RRO measurement based on one revolution is relatively larger than the standard deviation of an averaged RRO measurement based on multiple revolutions is irrelevant. (Advisory Action of 1/30/2006, pg. 2, emphasis added)

The skilled artisan clearly sees this statement is not true. Codilian '635 is all about "repeatable runnout (RRO) learning." For example, the title of the patent is "Method and Apparatus for RRO Learning...." Furthermore, each of the independent claims recites two or more "learning levels." This "RRO learning" of Codilian '635 is disclosed as a manner of

determining the RRO error by a process that is scalable in relation to the number of iterations for learning. (Codilian '635, col. 1 lines 34-37) The iterations involve updating RRO estimates for each sector in a track by comparing, sector-by-sector, a position error signal (PES) obtained during a disc revolution with a subsequent PES obtained during a subsequent disc revolution.

For this reason, Applicant argued and the Examiner agreed that Codilian '635 generally discloses employing a statistical determination of error on the basis of averages rather than individuals. (see Applicant's Response of 1/4/2006 ppg. 10-12; Advisory Action of 1/30/2006 para. 11) Accordingly, and as clearly described in at least in FIGS. 6A and 6B and the discussions thereof such as Equation 1, Codilian '635 clearly discloses that the amount of learning obtained is directly proportional to the number of learning disc revolutions.

The Examiner's untenable view requires completely ignoring the RRO learning of Codilian '635, which is the essential inventive subject matter of that reference according to its written description and claimed subject matter.

2. Codilian '635 Uses the Variable "N" to Define the Number of "Learning Disk Rotations"

The Examiner further stated the following as grounds for the final rejection:

> Codilian uses the variable "N" to define the first number of disk revolutions...
> (Advisory Action of 1/30/2006, emphasis added)

The skilled artisan clearly recognizes that this statement is also not true. Actually, Codilian '635 explicitly defines N in Equation 1 as being "the number of learning disk rotations used in the RRO measurement." (Codilian '635, col. 5 lines 41-42; see also col. 6 lines 33-35). The terms "revolutions" and "rotations" are interchangeable. Clearly, a "learning disk rotation" has a narrower meaning than a "disk rotation" in general, as the Examiner suggests, because "learning disk rotations" are those rotations during which RRO learning occurs. As discussed above, the RRO learning of Codilian '635 expressly requires reading the PES at a particular sector, and then subsequently reading the PES at the same sector again. The PES at the same sector cannot be read twice during one revolution.

Therefore, the meaning of "learning disk rotation" is two or more consecutive rotations during which RRO learning is occurring.

The Examiner's untenable view ignores the meaning of the variable N as it is explicitly defined and consistently used in Codilian '635.

3. Codilian Is Wholly Silent Regarding N=1

Finally, the Examiner stated the following as grounds for the final rejection:

> and no where in the specification is "N" limited to greater than 1.
> (Advisory Action of 1/30/2006)

The skilled artisan clearly recognizes that this statement is also not true. Applicant reiterates that the phrase "number of disk rotations" is used forty-six times in Codilian '635, and not once is it used in a way that can be reasonably understood to mean "one revolution" as the Examiner argues. (see Applicant's Response of 1/4/2006, pg. 11) It is noteworthy that although the Examiner argues generally that Codilian '635 contemplates N=1, he did not cite a passage supporting that argument because none exists.

Also, as discussed above, the skilled artisan readily recognizes that N, the number of learning disc revolutions, means two or more revolutions because the PES of a particular sector cannot be read twice during one revolution. The Examiner's untenable view seeks an explicit statement of what is obvious in view of the disclosure, and thereby goes without saying, to the skilled artisan reading Codilian '635.

Conclusion

Given these facts, Applicant believes that the Panel will reasonably conclude it cannot accept the Examiner's view of Codilian '635 as a bona fide view. The Examiner's untenable view requires ignoring Codilian '635's disclosure of RRO learning, which is its essential inventive subject matter. The Examiner's untenable view of Codilian '635 also ignores the explicit definition of "N," and is entirely based on hand-waving statements about the reference over what the reference explicitly states.

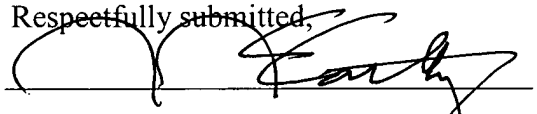
Furthermore, the Examiner's own arguments are contradictory. On the one hand the Examiner agrees that Codilian '635 discloses calculating error on the basis of averages rather

than individuals, but on the other hand the Examiner argues that Codilian '635 discloses reading sector-by-sector PES during only one revolution, making the obtaining of averages impossible.

Accordingly, this case is not in condition for appeal due to the unresolved factual issue that the Examiner has mischaracterized the cited reference beyond what a skilled artisan would understand it to reasonably disclose. The Examiner's mischaracterization is not a bona-fide view suited for appeal, but rather is a technical or obvious subterfuge that effectively closes the merits without stating grounds that the cited reference identically discloses reading position error signals for *non-consecutive revolutions* as in the present embodiments as claimed. This case is also not in condition for appeal due to the unresolved factual issue that absent the mischaracterization, the Examiner has not substantiated a *prima facie* case of anticipation because the cited reference does not identically disclose all the features of the rejected claims. Applicant now prays for an objective review of these factual deficiencies of these rejections and withdrawal of the same.

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,

By: 

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